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Respectfully submitted,

By: Thomas L. Evans  
Thomas L. Evans, PTO Reg. No. 35,805  
BANNER AND WITCOFF, LTD.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:

**Swatee N. SURVE**

Serial No.: 10/077,548

Filed: February 14, 2002

For: DEPOSITION OF ELECTRONIC CIRCUITS  
ON FIBERS AND OTHER MATERIALS

Atty. Docket No.: 005127.00138

Group Art Unit: 3765

Examiner: R. Muromoto, Jr.

Confirmation No.: 3233

**REQUEST FOR REINSTATEMENT OF APPEAL**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed May 3, 2005, Applicant respectfully asks for reinstatement of the appeal in this application initiated with the Notice Of Appeal filed on October 4, 2004.

Claims 1-25 are pending in the application, with claims 1 and 12 being independent claims. In a first Office Action dated December 22, 2003, the Examiner rejected claims 1-25. Subsequently, in a final Office Action dated June 2, 2004, the Primary Examiner rejected each of claims 1-25 based upon the original grounds of rejection. Appellant appealed the rejection of these claims on October 4, 2004, and filed an Appeal Brief in support of this appeal on February 4, 2005.

In response, the Primary Examiner withdrew the finality of the Office Action dated June 2, 2004, and issued a new Office Action on May 3, 2005. This new Office Action, however, maintains the previous rejection of claims 1, 4-12, 14-22, 24 and 25 without change. Instead, the Primary Examiner issued new grounds of rejection only for claims 3, 13 and 23.

Accordingly, Applicant requests that the appeal in this application be reinstated. In support of this request, Applicant is concurrently submitting a Supplemental Appeal Brief addressing the new grounds of rejection presented in the Office Action of May 3, 2005.

If the Commissioner deems it necessary for Applicant to submit a new Notice Of Appeal in order to obtain entry and consideration of the concurrently filed Supplemental Appeal Brief, it is respectfully requested that the Commissioner alternately treat this Request as a new Notice Of Appeal in this application.

It is believed that no fees are required for the consideration and entry of either this Request or the associated Supplemental Appeal Brief. If, however, the Commissioner deems that any fees are required for the consideration and entry of this request or the associated Supplemental Appeal Brief (or to otherwise maintain the pendency of this application), including any fees under 37 C.F.R. §1.16 and §1.17, the Commissioner is authorized to charge such fees to Deposit Account No. 19-0733.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: August 3, 2005

By:

  
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EV664640590US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

<i>In re</i> Application of	)	
	)	Group Art Unit: 3765
Swatee N. SURVE	)	
	)	Examiner: Robert J. Muromoto, Jr.
Serial Number 10/077,548	)	
	)	Attorney Reference: 005127.00138
Filed: February 14, 2002	)	
	)	
For: DEPOSITION OF ELECTRONIC	)	
CIRCUITS ON FIBERS AND OTHER	)	
MATERIALS	)	

**SUPPLEMENTAL APPEAL BRIEF**

Commissioner for Patents  
U.S. Patent and Trademark Office  
Alexandria, VA 22313

Sir:

Appellant hereby appeals to the Board of Patent Appeals and Interferences from the decision of the Primary Examiner on June 2, 2004, finally rejecting claims 1-25 in the above-captioned patent application, and the decision of the Primary Examiner on May 3, 2005, again rejecting claims 1-25 in the above-captioned patent application.

***(1) Real Party In Interest***

The real party in interest is Nike Inc., a U.S. corporation having a place of business at One Bowerman Drive, Beaverton, Oregon.

***(2) Related Appeals and Interferences***

Appellant and his legal representatives are unaware of any appeals or interferences related to the subject appeal.

### ***(3) Status of Claims***

Claims 1-25 (reproduced for reference in the Claims Appendix) are pending in the application, with claims 1 and 12 being independent claims. In a first Office Action dated December 22, 2003 and a final Office Action dated June 2, 2004, the Primary Examiner rejected each of claims 1-25. Appellant appealed the rejection of these claims on October 4, 2004, and filed an Appeal Brief in support of this appeal on February 4, 2005. In response, the Primary Examiner withdrew the finality of the Office Action dated June 2, 2004, and issued a new Office Action on May 3, 2005, again rejection each of claims 1-25.

### ***(4) Status of Amendments***

No amendments have been made to the claims during the pendency of this application.

### ***(5) Summary of Invention***

The present invention relates to a method of forming an article of wear by forming at least one electronic component on a fiber, interlacing the fiber with other fibers to form a piece of fabric, and then forming an article of wear with the fabric. (See, e.g., page 4, paragraph 16 to page 8, paragraph 27, and page 9, paragraph 9.) As described in the specification, the electronic component is formed on the fiber by spraying stock materials onto the fiber through a laser, so as to deposit the component on the fiber. (*Id.*, and particularly page 5, paragraph 19 to page 6, paragraph 20.) With some embodiments, a substrate is first formed on the fiber before the electronic component. (See, e.g., page 4, paragraph 16 to page 5, paragraph 17.) Some embodiments alternately or additionally form a protective layer over the electronic component. (See, e.g., page 7, paragraph 25 to page 8, paragraph 26.) Still other embodiments of the invention relate to a piece of clothing material and at least one electrical component formed over a surface of the piece of clothing material. (See, e.g., page 9, paragraph 30.)

**(6) Grounds Of Rejection To Be Reviewed<sup>1</sup>**

The following grounds of rejection are presented to the Board of Patent Appeals and Interferences for consideration in this appeal:

- (a) Claims 1, 4-12, 24 and 25 have been rejected under 35 U.S.C. §102(b) over U.S. Patent No. 6,210,771 to Post et al.
- (b) Claims 2, 3 and 13 have been rejected under 35 U.S.C. §103 over U.S. Patent No. 6,210,711 to Post et al. patent in view of U.S. Patent No. 6,251,488 to Miller et al.
- (c) Claim 23 has been rejected under 35 U.S.C. §103 over U.S. Patent No. 6,210,711 to Post et al. patent in view of U.S. Patent No. 6,251,488 to Miller et al., and in further view of U.S. Patent No. 5,555,490 to Carroll.

**(7) Arguments**

**Rejection Of Claims 1, 4-12, 24 and 25**

Claims 1, 4-22, 24 and 25 have been rejected under 35 U.S.C. §102(b) over U.S. Patent No. 6,210,771 to Post et al. Appellant respectfully traverses this rejection, and asks for its reconsideration.

Claims 1 and 4-11 recite a method of forming an article of wear that includes forming at least one electronic component on a fiber. Claims 12-22, 24 and 25 then recite an article of wear including at least one electrical component formed over a surface of a piece of clothing material. Appellant respectfully submits that these recited features of the invention are not taught or suggested by the Post et al. patent.

In making this rejection, the Primary Examiner states that:

Post discloses the fabrication of electronic devices and circuits, and in particular to the integration of such devices and circuit into textiles (fabrics, clothing material). (See Office Action, page 2, lines 15-16.)

Appellant does not dispute this assertion, or the Primary Examiner's apparent understanding of the disclosure in the Post et al. patent. Appellant submits, however, that no reasonable

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<sup>1</sup> In the Office Action of June 2, 2004, the Primary Examiner objected to the Abstract (1) for using the phrase "are disclosed" and (2) for reciting purported merits of the invention. This objection was not repeated in the outstanding Office Action of May 3, 2005. Accordingly, Appellant have concluded that this objection was withdrawn.

interpretation of the Post et al. patent can support the conclusion that this patent teaches or suggests the features of the invention recited in claims 1, 4-22, 24 and 25.

The Post et al. patent describes two techniques for creating electrical circuits using fibers. In the first technique,

...the [Post et al.] invention achieves selective, anisotropic electrical conductivity by utilizing conductive fibers running along one weave direction and non-conductive fibers running along the opposite direction. The conductive fibers serve as electrical conduits capable of carrying data signals and/or power, and may be connected, e.g., to electrical components soldered directly onto the fabric. (See the Post et al. patent at column 2, lines 12-20.)

With the second technique,

...the [Post et al.] invention comprises fabrication of circuit traces and passive electrical components into textiles using threads having selected electrical properties...For example, capacitors can be formed using extended parallel lanes of conductive material separated by non-conductive fabric that serves as a dielectric, or by spaced-apart patches of conductive material. Inductors and transformers can be formed from one or more spiral lengths of conductive material; in the case of a transformer, for example, the spirals may be concentrically disposed and magnetically coupled. (*Id.*, column 3, lines 9-23.)

Thus, the Post et al. discloses only four structures that might possibly be interpreted as electronic (or electrical) components: (1) the fibers themselves, (2) electrical components formed by multiple fibers working together, (3) the separate electrical components attached to the fibers, and (4) the circuit formed by the combination of the fibers with the separate electrical components. Each of these structures is patentably distinguishable from the claimed invention.

For example, if the Primary Examiner is interpreting a conductive fiber of the type disclosed by the Post et al. patent to itself be an electronic component, then this fiber cannot also be considered an electronic component formed on a fiber as recited in claims 1 and 4-11. That is, a fiber cannot be formed on itself. Accordingly, this interpretation cannot be stretched to anticipate the express language of claims 1 and 4-11.

Similarly, an electronic component formed by multiple fibers of the type disclosed in the Post et al. patent (e.g., a capacitor or conductor) also cannot be construed as an electronic component formed on a fiber. Instead, it can at most be characterized as a single electronic component incorporating a fiber, or as a group of electronic components positioned adjacent to each other.

With regard to the separate electrical components disclosed by Post et al. patent, this patent does not teach or suggest forming any of these separate components on a fiber as recited in claims 1 and 4-11. Instead, the Post et al. patent inherently teaches that these electrical components are formed elsewhere, and then subsequently welded or otherwise attached to a fiber.

Finally, with regard to a circuit created by attaching a separate electrical component to a fiber taught by the Post et al. patent (which appears to be the interpretation of the Post et al. patent relied upon by the Primary Examiner), Appellant likewise submits that this combination cannot be considered an electronic component formed on a fiber, as expressly recited in the claims. At best, it can only be construed as an electronic component that incorporates a fiber. More particularly, Appellant respectfully points out that the separate circuit component can only reasonably be characterized as a separately formed electronic component placed on a fiber, or as a part forming a larger circuit together with the fiber on which it is placed, but not both simultaneously as the Primary Examiner has done. While the Primary Examiner has dismissed Appellant's earlier arguments as "semantics," (see Advisory Action) Appellant is simply trying to point out that the Primary Examiner's reading of the claims onto the disclosure of the Post et al. is not only well beyond the broadest *reasonable* interpretation of these claims, but is in fact internally inconsistent.

In the final Office Action, the Primary Examiner asserted that

A direct quotation from Post reads 'The fibers of the fabric are used to create electrical circuits.' Electrical circuits are certain 'electronic components' under any definition.

Appellants do not dispute this assertion the Primary Examiner, but it does highlight the Primary Examiner's erroneous reading of the claims onto the Post et al. patent. Simply put, claims 1 and 4-11 do not broadly recite using fibers "to create" an electrical component, as suggested by the Primary Examiner. These claims instead more specifically recite forming at least one electronic component on a fiber, a feature that is not taught or suggested by the Post et al. patent. The Post et al. patent teaches forming electronic components that include a fiber. A fiber can either be part of an electronic component (as taught by the Post et al. patent), or the base on which an electronic

component is formed (as recited in the claims). A fiber cannot, however, simultaneously be both as argued by the Primary Examiner.

Similarly, Appellant respectfully submits that the Post et al. patent does not teach or suggest at least one electrical component formed over a surface of clothing material. Again, if the Primary Examiner interprets a conductive fiber of the type discussed in the Post et al. patent to itself be an electrical component, then this fiber cannot also be considered an electrical component formed over a surface of clothing material as recited in claim 12, 14-22, 24 and 25. Rather, the fiber is at most an electrical component that forms a part of a clothing material. Similarly, an electrical component formed by multiple fibers cannot be considered an electrical component formed over a surface of clothing material, but can only be considered an electrical component that forms a part of a clothing material.

With regard to the separate electrical components (e.g., capacitors) disclosed by Post et al., the Post et al. patent inherently teaches that these electrical components are formed elsewhere, and then subsequently welded or otherwise attached to a fiber, as previously noted. Thus, these separate components are not formed over a surface of clothing material as recited in claims 12, 14-22, 24, and 25. Appellant likewise submits that the combination of a separate electrical component attached to a fiber taught by Post et al. cannot be considered an electrical component formed over a surface of clothing material. Again, Appellant respectfully submits that the separate circuit component can be characterized as an electronic component attached to a clothing surface, or as a part forming a larger circuit in conjunction with the clothing surface, but not as both simultaneously.

Regarding claims 6, 8, 16 and 18, each of these claims recites a shield layer. The Primary Examiner has rejected these claims based upon the non-conductive coating disclosed in the Post et al. patent. Appellant respectfully points out, however, that electronic shielding typically is formed of conductive material. The Examiner did not address this discrepancy in either the final Office Action of June 2, 2004, or the more recent Office Action of May 3, 2005.

Accordingly, Appellant respectfully submits that the Post et al. patent does not teach or suggest the features of the invention recited in claims 1, 4-12, 14-22, 24 and 25. Appellant therefore again asks that the rejection of these claims be withdrawn.



### Rejection Of Claims 2, 3, And 13

Claims 2, 3 and 13 were newly rejected under 35 U.S.C. §103 over the Post et al. patent in view of U.S. Patent No. 6,251,488 to Miller et al.. Appellant respectfully traverses this rejection, and courteously asks for its reconsideration as well.

In making this rejection, the Primary Examiner stated:

This citation [Appellant's specification at page 8, paragraph 28, and at page 9, lines 11-15] admits the obviousness of using the techniques of Miller or any other suitable process for depositing electronic components and a substrate onto fibers as recited in claims 2, 3, and 13.

Therefore it would have been obvious to one of ordinary skill in the art *at the time of invention* to modify the Post article to use a spray deposition process as taught by Miller or any other suitable process for depositing electronic components rather than soldering, and depositing substrate materials onto fibers to be woven into fabric articles. (Office Action, page 5, lines 4-10, *emphasis added*.)

Appellant points out that this rejection is the very definition of impermissible hindsight. The Primary Examiner is expressly using the description of the invention in Appellant's specification to argue that an earlier combination of references would have been obvious. The reasoning provided by the Primary Examiner in the first paragraph above clearly does not support the Primary Examiner's conclusion emphasized in the following paragraph.

In fact, nothing in the Post et al. patent teaches or suggests forming an electrical component by spraying materials at a fiber through a laser. The Miller et al. patent, on the other hand, does not disclose forming an electronic component on either a fiber or on the surface of a piece of clothing material. Instead, the Miller et al. patent states:

Substrates suitable for use in the practice of the present invention include those *typically employed in the integrated circuit field*, such as metals, plastics (i.e., polymer resins, thermosets, and the like), glass, composites, ceramics, and the like. (See the Miller et al. patent, column 5, lines 34-38, *emphasis added*.)

Thus, there is simply nothing in either the Post et al. patent or the Miller et al. patent that would suggest using the techniques of the Miller et al. patent to form a circuit component on a fiber as asserted by the Primary Examiner. Moreover, the Post et al. patent does not remedy this omission of the Miller et al. patent. Appellant therefore respectfully submits that the combination of the Post et al. and Miller et al. patents is improper, and asks that the rejection of claims 2, 3 and 13 be withdrawn.

### Rejection Of Claim 23

Lastly, the Primary Examiner rejected claim 23 under 35 U.S.C. §103 over the Post et al. patent in view of the Miller et al. patent, and in further view of U.S. Patent No. 5,555,490 to Carroll. Appellant respectfully traverses this rejection, and asks for its reconsideration. Appellant again submits that the combination of the Post et al. and Miller et al. patents is improper, and the Carroll patent does not remedy the deficiencies in the Primary Examiner's combination of the Post et al. and Miller et al. patents. Moreover, in making this rejection, the Primary Examiner has combined the disclosure of leather materials in the Carroll patent with the use of the electrical fibers taught by the Post et al. patent. Leather does not employ fibers, however. Appellant therefore submits that one of ordinary skill in the art would not even know how to combine the Carroll patent and the Post et al. patent in the manner argued by the Examiner. Appellant therefore asks that the rejection of claim 23 be withdrawn as well.

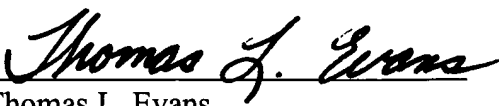
### ***(8) Conclusion***

The rejections submitted in the final Office Action of May 3, 2005, should be reversed for at least the reasons recited above. Allowance of claims 1-25 is, therefore, respectfully requested.

In accordance with 37 C.F.R. §41.37, Appellants submit this Appeal Brief to the Board of Patent Appeals and Interferences. A Notice of Appeal was timely filed on October 4, 2004, and the fee for filing an Appeal Brief was previously submitted prior to the Primary Examiner issuing the most recent Office Action of May 3, 2005. In addition, a Request For Reinstatement Of Appeal is being concurrently filed with this Appeal Brief. Accordingly, it is believed that no additional fees are due in connection with this Appeal Brief. Should additional fees be deemed necessary, however, such fees are hereby requested and the Commissioner is authorized to charge deposit account number 19-0733 for the payment of the requisite fee.

Favorable action with respect to this appeal is courteously requested.

Respectfully submitted,

By:   
Thomas L. Evans  
Registration No. 35,805

Banner & Witcoff, Ltd.  
1001 G Street, N.W.  
Washington, D.C. 20001-4597  
Telephone: (202) 824-3000

Dated: August 3, 2005

**Claims Appendix**  
**Claims Involved in the Appeal**

1. A method of forming an article of wear, comprising:  
forming at least one electronic component on a fiber;\ninterlacing the fiber with other fibers to form a piece of fabric; and  
forming an article of wear with the fabric.
2. The method of forming an article of wear recited in claim 1, wherein the at least one electronic component is deposited on the fiber by spraying stock materials at the fiber through a laser.
3. The method of forming an article of wear recited in claim 1, further comprising:  
forming a substrate over a surface of the fiber,  
wherein the at least one electronic component is formed over the substrate.
4. The method of forming an article of wear recited in claim 1, further comprising:  
forming a protective layer over the at least one electronic component.
5. The method of forming an article of wear recited in claim 4, wherein the protective layer is a layer of insulative material.
6. The method of forming an article of wear recited in claim 4, wherein the protective layer is a layer of shield material.
7. The method of forming an article of wear recited in claim 1, further comprising:  
forming an insulative layer over the at least one electronic component.
8. The method of forming an article of wear recited in claim 1, further comprising:  
forming a shield layer over the at least one electronic component.
9. The method of forming an article of wear recited in claim 1, wherein the at least one electronic component is a transistor.

10. The method of forming an article of wear recited in claim 1, wherein the at least one electronic element is an antenna element.

11. The method of forming an article of wear recited in claim 1, wherein the at least one electronic element is a capacitor.

12. An article of wear, comprising:  
a piece of clothing material; and  
at least one electrical component formed over a surface of the piece of clothing material.

13. The article of wear recited in claim 12, further comprising:  
a substrate formed on the surface of the piece of clothing material;  
wherein the at least one electrical component is formed over the substrate.

14. The article of wear recited in claim 12, further comprising:  
a protective layer formed over the at least one electronic component.

15. The article of wear recited in claim 14, wherein the protective layer is a layer of insulative material.

16. The article of wear recited in claim 14, wherein the protective layer is a layer of shield material.

17. The article of wear recited in claim 12, further comprising:  
an insulative layer formed over the at least one electronic component.

18. The article of wear recited in claim 12, further comprising:  
a shield layer formed over the at least one electronic component.

19. The article of wear recited in claim 12, wherein the at least one electronic component is a transistor.

20. The article of wear recited in claim 12, wherein the at least one electronic element is an antenna element.

21. The article of wear recited in claim 12, wherein the at least one electronic element is a capacitor.

22. The article of wear recited in claim 12, wherein  
the clothing material is a fabric woven from a plurality of fibers, and  
the at least one electrical component is formed over a surface of one of the plurality of fibers.

23. The article of wear recited in claim 12, wherein the clothing material is a natural or synthetic leather.

24. The article of wear recited in claim 12, wherein the clothing material is a plastic.

25. The article of wear recited in claim 12, wherein the clothing material is a composite foam.

**Evidence Appendix A**  
**First Office Action - Dated December 22, 2003**



CJR



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,548	02/14/2003	Swatee N. Surve	05127.00138	3233
22909	7590	12/22/2003	EXAMINER	
BANNER & WITCOFF, LTD. 1001 G STREET, N.W. WASHINGTON, DC 20001-4597			MUROMOTO JR, ROBERT H	
005127.00138			ART UNIT	PAPER NUMBER
2001-12-22			3765	

DATE MAILED: 12/22/2003

Amend dvi: 3.22.04  
 Last day: 6.22.04

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

DEC 22 2003

BANNER WITCOFF



**Office Action Summary**

AUG 03 2005

Application No.

10/077,548

Applicant(s)

SURVE, SWATEE N.

Examiner

Robert H Muromoto, Jr.

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

The abstract of the disclosure is objected to because the recitation "Fibers are disclosed..." and the abstract recite the purported merits of the invention. Correction is required. See MPEP § 608.01(b).

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-22, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Post et al. '771.

Post discloses the fabrication of electronic devices and circuits, and in particular to the integration of such devices and circuits into textiles (fabrics, clothing material). Post discloses a fabric woven with non-conductive fibers in the warp and a conductive fiber in the weft. The conductive fibers 110 may be continuously adjacent along the weft (substrate). The fibers of the fabric are used to create electrical circuits. The leads of a resistor and a **capacitor** 122 (claim 11, 21), as well as the pins of an integrated circuit 124 are soldered to single fibers of the fabric 100 (col.4, lines 15-51). A fabric comprising a woven matrix of conductive fibers running in both directions can be used to capacitively or electrically couple electronic components, or in sheet form can serve as an electrostatic antenna (claim 10, 20).

To prevent fibers 110 from making unwanted contact as a result of folding, the fabric 100 may be provided with a non-conductive (insulating, protective, shield, claims 4-8, and 14-18) coating (e.g., a transparent acrylic coating that may be sprayed on) following affixation of the electronic components. Alternatively, an insulating layer 135 may be applied to one or both sides of the fabric 100. Insulating layer can, if desired, be a textile with handling characteristics similar to those of the fabric 100 (col. 4, lines 58-65).

Electrically active textiles can also be created by sewing, embroidery or weaving of conductive material into a substantially non-conductive fabric matrix or substrate. Typically, the threads are formed by spinning together fibers of a polymer (plastic, claim 24) such as KEVLAR® with fibers of a metal.

Another embodiment uses an elastic (e.g., foam, claim 25) panel to provide resistance in a switching mechanism for the circuit.

In yet another embodiment, the strips of conductor material may be coated with a semiconductor to form nonlinear thresholding elements at the overlap regions that prevent false contacts and/or phantom switching. The use of the semiconductor makes the electrical component a transistor, as recited by the applicant in claims 9 and 19.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Post et al., in view of Skszek.

Although Post teaches essentially all of the limitations of the instant invention there is no teaching of using a laser spray process to form the electrical components on the fibers.

However, Skszek teaches a process of laser-based direct-metal disposition (spray) to provide unique physical and mechanical properties including structural strength, and wear resistance to laminate composite materials, which include metal in the structure.

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to use a laser spray process to form the electrical components on the fibers of the fabric of Post, rather than soldering the metal components onto the fibers, to take advantage of the increased structural strength and wear resistance of the laser based disposition process.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Post et al., in view of Carroll.

Although Post teaches essentially all of the limitations of the instant invention, there is no teaching of using either synthetic or natural leather as a clothing material.

However, Carroll teaches a wearably personal computer system which uses leather as an inexpensive and flexible material in a garment formed with electrical components integrated within the structure. Leather is a very well known material in all types of apparel, and can be easily produced at relatively low cost.

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to use leather as the flexible material of an electronically active garment.

**Conclusion**


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Several references teaching garments that include electronic components have been cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert H Muromoto, Jr. whose telephone number is 703-306-5503. The examiner can normally be reached on 8-530, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on 703-305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

Bhm  
December 12, 2003

  
JOHN S. CALVERT  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

<b>Notice of References Cited</b>	Application/Control No. 10/077,548	Applicant(s)/Patent Under Reexamination SURVE, SWATEE N.	
	Examiner Robert H Muromoto, Jr.	Art Unit 3765	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-5,555,490	09-1996	Carroll, David W.	361/686
	B	US-6,210,771	04-2001	Post et al.	428/100
	C	US-6,472,029	10-2002	Skszek, Timothy W.	427/554
	D	US-6,080,690	06-2000	Lebby et al.	442/209
	E	US-5,906,004	05-1999	Lebby et al.	2/1
	F	US-6,006,357	12-1999	Mead, James E.	2/160
	G	US-5,771,492	06-1998	Cozza, Frank C.	2/161.2
	H	US-5,655,223	08-1997	Cozza, Frank C.	2/161.2
	I	US-5,636,378	06-1997	Griffith, Quentin L.	2/455
	J	US-3,632,966	01-1972	Arron, Stanley	219/211
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

MH

**Evidence Appendix B**  
**Final Office Action - Dated June 2, 2004**





UNITED STATES PATENT AND TRADEMARK OFFICE

CJR/TLE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/077,548

02/14/2002

Swatee N. Surve

05127.00138

3233

22909

7590

06/02/2004

BANNER & WITCOFF, LTD.

1001 G STREET, N.W.

WASHINGTON, DC 20001-4597

EXAMINER

MUROMOTO JR, ROBERT H

ART UNIT

PAPER NUMBER

3765

005127.00138  
DOCKETED SH

DATE MAILED: 06/02/2004

JUN 4 2004

amend after final / AOA  
due: 9.2.04

Last day: 12.2.04

Please find below and/or attached an Office communication concerning this application or proceeding.



RECEIVED

JUN 04 2004

BANNER & WITCOFF

# Office Action Summary

Application No.

10/077,548

Applicant(s)

SURVE, SWATEE N.

Examiner

Robert H Muromoto, Jr.

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Specification***

The abstract of the disclosure is objected to because the recitation "Fibers are disclosed..." and the abstract recites the purported merits of the invention. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-22, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Post et al. '771.

Post discloses the fabrication of electronic devices and circuits, and in particular to the integration of such devices and circuits into textiles (fabrics, clothing material). Post discloses a fabric woven with non-conductive fibers in the warp and a conductive fiber in the weft. The conductive fibers 110 may be continuously adjacent along the weft (substrate). The fibers of the fabric are used to create electrical circuits. The leads of a resistor and a capacitor 122 (claim 11, 21), as well as the pins of an integrated circuit 124 are soldered to single fibers of the fabric 100 (col.4, lines 15-51). A fabric comprising a woven matrix of conductive fibers running in both directions can be used to capacitively or electrically couple electronic components, or in sheet form can serve as an electrostatic antenna (claim 10, 20).

To prevent fibers 110 from making unwanted contact as a result of folding, the fabric 100 may be provided with a non-conductive (insulating, protective, shield, claims 4-8, and 14-18) coating (e.g., a transparent acrylic coating that may be sprayed on) following affixation of the electronic components. Alternatively, an insulating layer 135 may be applied to one or both sides of the fabric 100. Insulating layer can, if desired, be a textile with handling characteristics similar to those of the fabric 100 (col. 4, lines 58-65).

Electrically active textiles can also be created by sewing, embroidery or weaving of conductive material into a substantially non-conductive fabric matrix or substrate. Typically, the threads are formed by spinning together fibers of a polymer (plastic, claim 24) such as KEVLAR® with fibers of a metal.

Another embodiment uses an elastic (e.g., foam, claim 25) panel to provide resistance in a switching mechanism for the circuit.

In yet another embodiment, the strips of conductor material may be coated with a semiconductor to form nonlinear thresholding elements at the overlap regions that prevent false contacts and/or phantom switching. The use of the semiconductor makes the electrical component a transistor, as recited by the applicant in claims 9 and 19.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Post et al., in view of Skszek.

Although Post teaches essentially all of the limitations of the instant invention there is no teaching of using a laser spray process to form the electrical components on the fibers.

However, Skszek teaches a process of laser-based direct-metal disposition (spray) to provide unique physical and mechanical properties including structural strength, and wear resistance to laminate composite materials, which include metal in the structure.

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to use a laser spray process to form the electrical components on the fibers of the fabric of Post, rather than soldering the metal components onto the fibers, to take advantage of the increased structural strength and wear resistance of the laser based disposition process.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Post et al., in view of Carroll.

Although Post teaches essentially all of the limitations of the instant invention, there is no teaching of using either synthetic or natural leather as a clothing material.

However, Carroll teaches a wearably personal computer system which uses leather as an inexpensive and flexible material in a garment formed with electrical components integrated within the structure. Leather is a very well known material in all types of apparel, and can be easily produced at relatively low cost.

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to use leather as the flexible material of an electronically active garment.

***Response to Arguments***

Applicant's arguments filed 3/26/2004 have been fully considered but they are not persuasive. Applicant argues that Post does not teach "forming an electronic component on either a fiber or over a surface of a piece of clothing material".

It is the examiner's position that Post clearly shows the forming of an electronic component on a fiber or over a surface of cloth material. Especially important disclosures from Post have been italicized above for emphasis, no new recitations have been added to the previous rejection.

As evidence the examiner uses the language provided directly from the applicant's remarks filed 3/26/2004. "...Post describes fabric material wherein the fibers themselves are used to conduct electricity to or from electronic components." This statement alone states that the fibers which are a "surface of a piece of clothing material" are used to conduct electricity. If the fibers conduct electricity then they are part of the "electronic component".

Additionally, also taken from the applicant's remarks, "...electronic components are then connected to the conductive fibers by, e.g., soldering..." This statement describes the forming of an electronic component over the surface of a cloth material. The "electronic component" is soldered to the fabric, which is equivalent to "forming over a surface of a piece of clothing material.", as recited in the claims.

When using the broadest reasonable interpretation, Post clearly anticipates the limitation, "forming an electronic component on either a fiber or over a surface of a piece of clothing material." A direct quotation from Post reads, "The fibers of the fabric are used to create electrical circuits.", electrical circuits are certainly "electronic components" under any definition. The previous rejection remains and is considered proper.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert H Muromoto, Jr. whose telephone number is 703-306-5503. The examiner can normally be reached on 8-530, M-F.

Art Unit: 3765

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on 703-305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bhm  
May 27, 2004

  
JOHN J. CALVERT  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700



**Evidence Appendix C**  
**Non-Final Office Action - Dated May 3, 2005**



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,548	02/14/2002	Swatee N. Surve	05127.00138	3233

EXAMINER
MUROMOTO JR, ROBERT H

ART UNIT	PAPER NUMBER
3765	

22909 7590 05/03/2005  
BANNER & WITCOFF, LTD.  
1001 G STREET, N.W.  
WASHINGTON, DC 20001-4597

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Docketed 5/9/05  
Attny BSK/TLE/PORTLAND  
Case Ref 005127-0038  
Action 3 MO RESP DUE  
Due Date 8/3/05  
Last Day 11/3/05  
By BE

RECEIVED

MAY 05 2005

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/077,548	SURVE, SWATEE N.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Robert H Muromoto, Jr.	3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### Examiner's Comment

Upon review of the appeal brief filed 2/4/2005, finality of the previous rejections in the instant application has been withdrawn. The previous rejection's have been modified and are presented below.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-12, 14-22, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Post et al. '771.

Post discloses the fabrication of electronic devices and circuits, and in particular to the integration of such devices and circuits into textiles (fabrics, clothing material). Post discloses a fabric woven with non-conductive fibers in the warp and a conductive fiber in the weft. The conductive fibers 110 may be continuously adjacent along the weft (substrate). The fibers of the fabric are used to create electrical circuits. The leads of a resistor and a capacitor 122 (claim 11, 21), as well as the pins of an integrated circuit 124 are soldered to single fibers of the fabric 100 (col.4, lines 15-51). A fabric comprising a woven matrix of conductive fibers running in both directions can

be used to capacitively or electrically couple electronic components, or in sheet form can serve as an electrostatic antenna (claim 10, 20).

To prevent fibers 110 from making unwanted contact as a result of folding, the fabric 100 may be provided with a non-conductive (insulating, protective, shield, claims 4-8, and 14-18) coating (e.g., a transparent acrylic coating that may be sprayed on) following affixation of the electronic components. Alternatively, an insulating layer 135 may be applied to one or both sides of the fabric 100. Insulating layer can, if desired, be a textile with handling characteristics similar to those of the fabric 100 (col. 4, lines 58-65).

Electrically active textiles can also be created by sewing, embroidery or weaving of conductive material into a substantially non-conductive fabric matrix or substrate. Typically, the threads are formed by spinning together fibers of a polymer (plastic, claim 24) such as KEVLAR® with fibers of a metal.

Another embodiment uses an elastic (e.g., foam, claim 25) panel to provide resistance in a switching mechanism for the circuit.

In yet another embodiment, the strips of conductor material may be coated with a semiconductor to form nonlinear thresholding elements at the overlap regions that prevent false contacts and/or phantom switching. The use of the semiconductor makes the electrical component a transistor, as recited by the applicant in claims 9 and 19.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2, 3, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Post et al., in view of Miller 6,251,488.

Although Post teaches essentially all of the limitations of the instant invention there is no teaching of using a laser spray process to form the electrical components on the fibers or the formation of a substrate on the fibers prior to affixing the electronic components onto the fibers.

However, as stated in applicant's own specification on page 8, paragraph 28, and on page 9, lines 11-15, "It should be noted that the substrate 203, the protective layer 225, and the shielding layer 227 can each be created using the techniques disclosed in the Miller patent referenced above. Because these structures do not require a high degree of resolution, however, these structures can also be formed using less precise techniques, such as simply dipping the fiber 203 in a liquid form of the material to be used for the substrate 203, the protective layer 225, or the shielding layer 227. These structures can also be formed by, e.g., conventional gas deposition, spraying, or any other suitable technique (page 8, paragraph 28, instant specification)."

"Thus those of ordinary skill in the art will understand that, according to the teachings of the invention, any structure that can be fabricated using the Miller

Art Unit: 3765

technique or other suitable technique can be formed on a fiber in such a way that the fiber may be subsequently woven into a fabric for clothing or other articles of wear (page 9, lines 11-15, instant specification)."

This citation admits the obviousness of using the techniques of Miller or any other suitable process for depositing electronic components and a substrate onto fibers as recited in claims 2, 3, and 13.

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to modify the Post article to use a spray deposition process as taught by Miller or any other suitable process for depositing electronic components rather than soldering, and depositing substrate materials onto fibers to be woven into fabric articles.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Post et al., in view of Miller and further in view of Carroll.

Although Post and Miller teach essentially all of the limitations of the instant invention, there is no teaching of using either synthetic or natural leather as a clothing material.

However, Carroll teaches a wearable personal computer system which uses leather as an inexpensive and flexible material in a garment formed with electrical components integrated within the structure. Leather is a very well known material in all types of apparel, and can be easily produced at relatively low cost.

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to use leather as the flexible material of an electronically active garment.

***Response to Arguments***

Applicant's arguments filed 2/4/2005 have been fully considered but they are not persuasive. Applicant argues that Post does not teach "forming an electronic component on either a fiber or over a surface of a piece of clothing material".

It is the examiner's position that Post clearly shows the forming of an electronic component on a fiber or over a surface of cloth material. Especially important disclosures from Post have been italicized above for emphasis, no new recitations have been added to the previous rejection.

This citation taken from the applicant's remarks, "...electronic components are then connected to the conductive fibers by, e.g., soldering..." This statement describes the forming of an electronic component over the surface of a fiber and therefore over a cloth material. The "electronic component" is soldered to the fabric, which is equivalent to "forming on a surface of a piece of clothing material." as recited in the claims.

When using the broadest reasonable interpretation, Post clearly anticipates the limitation, "forming an electronic component on either a fiber or over a surface of a piece of clothing material.

The Examiner cites, Webster's dictionary for a definition of the word "on" recited in the independent claims. "On: used as a function word to indicate presence within the confines of"; Post discloses, "The leads of a resistor 120 and a capacitor 122, as well as the pins of an integrated circuit 124 are soldered to single fibers of the fabric 100 (col. 4, lines 35-40)." The soldering of electronic components clearly meets the definition of



Art Unit: 3765

"forming electronic components on a fiber" and "over a clothing material" as the surface of the fibers is the surface of the clothing material.

Applicant's argument with respect to claims 2, 3 and 13 are moot as these claims are now rejected by Miller.

Applicant's argument with respect to claim 23 is not persuasive, leather and artificial leather have been used as materials for all types of clothing to take advantage of leather's intrinsic properties (low cost, durability, aesthetic). The examiner as evidence has cited a wearable personal computer that teaches leather as a low cost and flexible material as a possible material. A wearable personal computer is clearly in the same problem solving area as the instant invention. Additionally, the use of leather or synthetic leather in all types of apparel is not novel.


#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert H Muromoto, Jr. whose telephone number is 571-272-4991. The examiner can normally be reached on 8-530, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on 703-305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bhm  
April 28, 2005

  
JOHN V. CALVERT  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

<b>Notice of References Cited</b>	Application/Control No. 10/077,548	Applicant(s)/Patent Under Reexamination SURVE, SWATEE N.	
	Examiner Robert H Muromoto, Jr.	Art Unit 3765	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-6,251,488	06-2001	Miller et al.	427/596
	B	US-4,723,589	02-1988	Iyer et al.	164/46
	C	US-6,580,959 B1	06-2003	Mazumder, Jyoti	700/121
	D	US-6,620,645 B2	09-2003	Chandra et al.	438/98
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	M	US-			

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\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

**Evidence Appendix D**  
**U.S. Patent Number 6,210,771 to Post et al.**

This reference was originally entered into the record by the Examiner in the Office Action dated December 22, 2003.

**Evidence Appendix E**  
**U.S. Patent Number 6,251,488 to Miller et al.**

This reference was originally entered into the record by the Examiner in the Office Action dated May 3, 2005, but was cited in Appellant's specification.

**Evidence Appendix F**  
**U.S. Patent Number 5,555,490 to Carroll**

This reference was originally entered into the record by the Examiner in the Office Action dated December 22, 2003.

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